REMARKS

This responds to the Final Office Action dated on January 25, 2005.

Claims 1-2 are amended, claims 6 and 12 are canceled, and no claims are added; as a result, claims 1-5, 7-11 and 13 remain pending in this application.

§103 Rejection of the Claims

Claims 1 and 3-8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Chan et al. in view of Poisson et al. (U.S. 2003/0033401). In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)). Applicant respectfully submits that the claims as amended to not teach or disclose each and every element of Applicant's claims.

For example, claim 1 as amended recites "a service processing switch having a plurality of network resources allocatable to one or more virtual routers, wherein a subset of the virtual routers are allocatable to each of a plurality of subscribing enterprises." Applicant has reviewed Chan and Poisson, including performing a computerized text search, and can find no reference to a virtual router in either Chan or Poisson. Further, with respect to the virtual router element of Applicant's amended claim 1, the Office Action, in the rejection of now canceled claim 6, states:

> As per claims 3-8, the combination Chan and Poisson implicitly and explicitly teach a plurality of network resources that includes a packet filter, firewall, network address translation module, a virtual router a VPN and multiple processing elements (see Chan's fig 3-8 and section 4 of Chan reference).

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The statement from the Office Action quoted above provides no basis for understanding clearly what elements in Chan or Poisson that the Examiner is equating to the virtual router recited in Applicant's claim 1. MPEP §706 indicates that "The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity." Further, 27 CFR 1.104 (2) states that "The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified." The Final Office Action does not clearly explain the pertinence of the reference, and the pertinence is not apparent from the reference itself or the sections cited in Chan.

Similarly, in response to Applicant's arguments, the Office Action states "Furthermore, regarding a virtual router and firewall, all those limitations are inherent in a VPN environment (see section 4 of Chan's reference)." Thus the Final Office Action appears to be assuming that a virtual router is inherent in Chan. Applicant respectfully disagrees because the Office Action has not established a *prima facie* case of inherency because, as recited in MPEP § 2112, "In relying upon the theory of inherency, the examiner must provide basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic <u>necessarily</u> flows from the teachings of the applied prior art," citing <u>Ex parte Levy</u>, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

The Office Action only argued that a virtual router is inherent in a VPN environment Thus, the Office Action does not even assert that the allegedly inherent characteristic is necessary, let alone provide a basis in fact and/or technical reasoning. Applicant respectfully submits that a virtual router does not necessarily flow from either Chan or Poisson because a VPN may exist in the absence of a virtual router. The mere presence of a VPN does not imply a virtual router, nor does the presence of a virtual router imply the presence of a VPN. Each are independent of one another and provide different functionality within a network. As a result, a virtual router does not necessarily flow from a VPN.

To serve as an anticipation when a reference is silent about the asserted inherent characteristic, the gap in the reference may be filled with recourse to extrinsic evidence. But, such evidence must make clear that "the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill."

Continental Can Co. v. Monsanto Co., 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). Applicant respectfully submits that the Examiner has not produced extrinsic evidence to show that the virtual router recited in claim 1 is necessarily present in Chan or Poisson.

In view of the above, Applicant respectfully submits that neither Chan nor Poisson teach or disclose a virtual router as recited in Applicant's claim 1. Therefore the combination of Chan and Poisson fails to teach or disclose each and every element of claim 1. As a result, the combination of Chan and Poisson does not present a *prima facie* case of obviousness with respect to claim 1. Applicant respectfully requests reconsideration and the withdrawal of the rejection of claim 1.

Claims 3-5 and 7-8 depend either directly or indirectly from claim 1, and are patentable over Chan and Poisson for the reasons argued above, and are also patentable in view of the additional elements which they provide to the patentable combination. If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is also nonobvious. MPEP § 2143.03.

Additionally, with respect to claim 4, Applicant notes that the Office Action makes the same argument with respect to a firewall element that was made with respect to the virtual router now included in Amended claim 1. Applicant respectfully submits that the inclusion of a firewall on a processing element within a service processing switch is not taught by Chan or Poisson, nor is it inherent in Chan or Poisson. Further, providing a firewall within a service processing switch that may be controlled by a subscriber is also not found in either Chan or Poisson. Chan does not teach or disclose a firewall at all, and Poisson merely mentions in paragraph 27 that VPN functionality may be provided in a firewall. Neither reference discloses that a firewall service may be provisioned as a network resource within a service processing switch, and that the firewall may be allocated to a subscriber.

§102 Rejection of the Claims

Claims 2 and 9-13 were rejected under 35 U.S.C. § 102(b) for anticipation by Chan et al. ("Customer Network Management and Control of Broadband VPN Services, " Proc. IFIP/IEEE International Symposium on Integrated Network Management, May 1997, pp. 301-314). Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon* 919 F.2d 688, 16 USPQ2d 1897, 1908 (Fed. Cir. 1990) (en

banc), cert. denied, 500 U.S. 904 (1991). Applicant respectfully submits that claim 2, as amended, contains elements not found in Chan.

Claim 2 as amended, like claim 1 discussed above, recites a virtual router. Again, the Office Action, with respect to the virtual router of now canceled claim 12, does not clearly state what element of Chan corresponds to a virtual router. As discussed above, Chan does not teach or disclose a virtual router, nor is a virtual router inherent in Chan. As a result, Chan does not teach or disclose each and every element of Applicant's claim 2. Applicant respectfully requests reconsideration and the withdrawal of the rejection of claim 2.

Claims 9-11 and 13 depend from claim 2, and therefore inherit the virtual router element of claim 2. These dependent claims are therefore not anticipated for the same reasons as discussed above.

Additionally, claims 9-11 recite a packet filter, a firewall service and a network address translation module respectively. Applicant has reviewed Chan, and can find no teaching or disclosure of these elements in Chan. With respect to claims 9-11, the Office action states:

> As per claims 9-13, the combination Chan and Poisson inherently
> and explicitly teach a plurality of network resources that includes a
> packet filter, firewall, network address translation module, a virtual
> router a VPN and multiple processing elements (see Chan's fig 3-8
> and section 4 of Chan reference).

However, the Office Action does not clearly state what elements in Chan correspond to the packet filter, firewall or network address translation module of Applicant's claims 9-11. Additionally, the elements are not inherent in Chan. The Office Action has not provided basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. In view of the above, Applicant respectfully submits that Chan does not teach or disclose each and every element of claims 9-11. Applicant respectfully requests reconsideration and the withdrawal of the rejection of claims 9-11.

CONCLUSION

Applicant respectfully submits that the pending claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612) 373-6954 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.
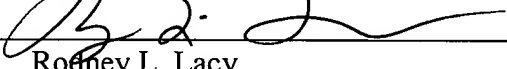
Respectfully submitted,

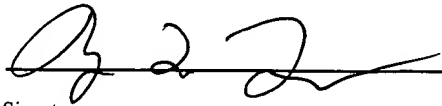DAITHI LARKIN ET AL.

By their Representatives,

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Date March 7, 2006   By _____
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Petition, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this   7th   day of March, 2006.

Rodney L. Lacy _____

Name

_____
Signature